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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,161	02/23/2004	Dmitry I. Belov	029279-5001US	8494
28977 7590 12/19/2008 MORGAN, LEWIS & BOCKIUS LLP 1701 MARKET STREET PHILADELPHIA, PA 19103-2921				
EXAMINER				
MOSSER, KATHLEEN MICHELLE				
ART UNIT		PAPER NUMBER		
3715				
MAIL DATE		DELIVERY MODE		
12/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,161

Applicant(s)

BELOV, DMITRY I.

Examiner

Kathleen Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 10/16/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

In response to the reply filed 10/16/2008, claims 1-24 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/2008 has been entered.

Declaration filed under 37 CFR 1.132

2. The affidavit of Dmitry Belov under 37 CFR 1.132 filed 10/18/2008 is insufficient to overcome the rejection of claims 1-24 based upon the article "A Stochastic Search for Test Assembly, Item Pool Analysis, and Design" as set forth in the last Office action because: The affidavit fails to provide objective evidence as to the improper dates of the prior art, and incorrectly identifies the citations associated with the asserted contributions of co-author Ronald Armstrong.. The affidavit asserts that Ronald Armstrong is responsible for the use of a "maximum set packing formulation, purportedly on page 5 of the article., and for the use of comparing two different pools, on page 6 of the article. These features are not found on these pages of the article. It appears that "maximum set packing" is found on page 10 and the use of comparing two different pools is on page 11, under the title "Section 4" of the article. From review of these sections, it appears these are indeed the subject matter of at least claims 10-12 and 22-24. As the affidavit does not identify any context of these contributions, it is unclear how Ronald Armstrong's contributions are outside the content of these claims. Given this lack of clarity, the affidavit is not accepted.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 10-12 and 22-24 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. In the affidavit submitted 10/18/2008, the applicant states that Ronald Armstrong is the inventor of the use of a "maximum set packing" and "comparison of two different pools". This is the subject matter of the above claims.

4. Claims 1-2, 13 and 14 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The article "Developing and Assembling the law School Admission Test" written by co-authors Ronald Armstrong, Dmitry Belov, and Alexander Weissman states the LSAC has used a Monte Carlo approach to the assembly of test forms for the LSAT since 2002. This method is shown on page 144 of the article under "Monte Carlo Test Assembler". This section describes the process identically to that of the above claims.

5. Claims 1-24 are rejected under 35 U.S.C. 102(a) as being anticipated by "A Stochastic Search for Test Assembly, Item Pool Analysis, and Design", Belov and Armstrong, January 2004 (cited by applicant, herein after the Belov/Armstrong Article). Belov/Armstrong teaches a plurality of methods, intended to be implemented on a computer (thus a computer readable medium including for creating sub-pools of questions from a larger item pool. The larger item pool is shown on Page 5 line 20-21. The method of claims 1, 2, 13 and 14 is shown in Page 5, as steps 1 and 2 of the Monte Carlo analysis. With respect to

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claims 3-5 and 15-18, these methods correlate to the procedures taught as "Method 1" of the Belov/Armstrong Article starting on page 6. With respect to claims 7 and 19, this method is described as "Method 3" of the Belov/Armstrong article starting on page 9. With respect to claims 8, 9, 20 and 21, this method correlated to "Method 2" of the Belov/Armstrong article, starting on page 8. With respect to claims 10-12 and 22-24, the methods for assembling the sub-pools are described in Section 3 of the Belov/Armstrong article.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process. None of claims 1-12 recite any tie to a machine, act upon any machine, or transform any article. These claims function upon data (the item pools), which is not a physical article. Given this, the claims are drawn to non-statutory subject matter.

Response to Arguments

7. Applicant's arguments filed 10/18/2008 have been fully considered but they are not persuasive. Applicant's arguments are directed solely to the disqualification of the Belov/Armstrong article as prior art. These issues are fully addressed in the rejection of the claims and analysis of the affidavit above.

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Conclusion

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

December 15, 2008

Request for Information under 37 CFR §1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:

1. The information is required to identify products and services embodying the disclosed subject matter of the creation of sub-pools of test items based upon Monte Carlo analysis, hierarchical diagramming of test constraints, and multiple pool/sub-pools analysis and identify the properties of similar products and services found in the prior art.
2. In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of test item sub-pool creation. In addition, for each of these articles or those previously cited, the applicant is requested to identify the contributions of each of the authors to the article.
3. In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to developing constraint analysis of a sub-pool. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.
4. In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter. The examiner particularly notes the cited article entitled "Developing and Assembling the law School Admission Test", which references a product used by the LSAC since 2002 which embodies at least portions of the claimed invention. Applicant is requested to provide information concerning the operational algorithms employed in this product. Further, applicant is

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requested to identify the similarities and difference, if any, which exist between this product and the instantly claimed invention.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

/Robert P Olszewski/

Director, Technology Center 3700